

## REMARKS

Claims 58-74 are currently pending in this application. In the Office Action mailed on February 26, 2008 ("Office Action"), claims 58-74 were rejected. Through this amendment, Applicants have amended independent claim 58 and dependent claims 61 and 71. Claims 60 and 70 have been canceled without prejudice. No new matter has been entered. Applicants respectfully request favorable consideration of the present application in light of the amendments to the claims and the following remarks.

### **I. Claim Rejections– 35 USC § 103(a) – Allen in view of Ouchi**

Claims 58-65 and 67-69 were rejected under 35 USC § 103(a) as being unpatentable over US Patent No. 5,733,288 to Allen ("Allen") in view of US Patent No. 5,899,850 to Ouchi ("Ouchi '850"). Applicants respectfully traverse this rejection as set forth below.

To establish a *prima facie* case of obviousness under 35 USC § 103(a) in view of a reference or combination of references, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art reference(s) must teach or suggest all the claim limitations. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. Finally, in determining the differences between the prior art and the claims, the question under 35 USC § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.

Claim 58, as amended, describes a method for removing intervertebral disc material. The first step involves creating a working channel from a patient's skin to an intervertebral disc

space. The second step involves positioning a protector near an entrance into the intervertebral disc space between a brush member and at least one of neural tissue, dura tissue, and vasculature adjacent to the entrance. The protector has a longitudinal axis and includes a retractor having at least two blade members for establishing a barrier between the brush member and the body tissue adjacent to the entrance. The blade members have a generally rectangular planar shape, and are positioned in a co-planar orientation relative to the longitudinal axis. The third step involves inserting a brush member into the intervertebral disc space, wherein the brush member has a length ranging from 0.25 to 4.0 inches, a diameter ranging from 0.082 to 1.225 inches, and a plurality of bristle members disposed in a helical configuration defining a capacity for carrying intervertebral disc material. The fourth step involves manipulating the brush member within the intervertebral disc space to receive intervertebral disc material within the brush member. The fifth step involves removing the brush member from the intervertebral disc space.

Neither the Allen nor the Ouchi '850 references, alone or in combination, appear to teach or disclose each and every element found in claim 58, such that the rejection under 35 USC § 103 should be withdrawn. The Allen reference does not disclose the element of claim 58 of the present invention that involves a protector **"having a longitudinal axis"** with **"blade members having a generally rectangular planar shape, said blade members positioned in a co-planar orientation relative to said longitudinal axis."** The Allen reference doesn't disclose any protector whatsoever.

Ouchi '850 does not cure the aforementioned deficiencies in what was fairly taught by Allen. Ouchi '850 may disclose a cover tube (Fig. 16, ref. 5) that encloses the brush portion (Fig. 16, ref. 2). However, Ouchi '850 does not disclose a protector **"having a longitudinal axis"** with **"blade members having a generally rectangular planar shape, said blade members positioned in a co-planar orientation relative to said longitudinal axis."** As opposed to Applicant's protector, which is generally rectangular and planar, Ouchi '850 discloses a cover tube that is made up of arc segments curving toward the brush portion (Fig 4, ref. 14A). Furthermore, Applicant's blade members are positioned in a plane that is generally parallel to the

longitudinal axis of the protector. (Fig. 12) The generally rectangular planar blade members, rotatable in one embodiment (Fig. 13 and claim 73), only rotate in a direction that maintains the co-planar orientation. The Ouchi '850 cover tube contains slits (Fig. 4, ref. 6) which allow the openable portions (Fig. 4, ref. 14A) to move in a direction that is not coplanar to the longitudinal axis of the instrument (Ouchi '850 Fig 2A-2B, 4, 14). The Ouchi '850 cover tube is neither of a generally rectangular planar shape, nor is it positioned in a co-planar orientation relative to the longitudinal axis.

Therefore, given these voids, one of ordinary skill in the art would not have been motivated to combine the Allen and Ouchi '850 references, nor would such a combination have led them to arrive at the present invention as claimed. Because Allen and Ouchi '850 fail to teach or disclose each and every claimed feature in the independent claim 58, Applicants respectfully submit that the rejection under 35 USC § 103(a) should be withdrawn in favor of an indication of allowance, which is hereby earnestly solicited.

Based on the foregoing, Applicants respectfully submit that the Allen and Ouchi '850 references, whether taken alone or in combination, fail to contain the requisite teaching or suggestion that would have lead one of ordinary skill in the art to the present invention. Claims 59, 61-65, and 67-69, being dependent upon and further limiting claim 58, should be allowed for the reasons set forth above in support of the allowability of claim 58, as well as the additional features they contain. Applicants respectfully request that the rejection of claims 58, 59, 61-65, and 67-69 be withdrawn in favor of an indication of allowance, which is hereby earnestly solicited.

#### **B. Allen in view of Ouchi in view of Ouchi**

Claims 70-74 were rejected under 35 USC § 103(a) as being unpatentable over Allen in view of Ouchi '850 in view of Ouchi (US Patent No. 6,210,377 B1, "Ouchi '377"). Applicants respectfully traverse this rejection in light of the amendments to the claims and as set forth below.

In order for combined references to anticipate the present claimed invention under 35 USC § 103(a), the references must teach or suggest all of the claim limitations when combined. If it can be shown that one element of the claim is missing or not met by the cited references, the rejection must be withdrawn as inappropriate.

Claims 70-74 depend from independent claim 58. As noted above, both Allen and Ouchi '850 fail to teach or disclose each and every feature found in independent claim 58. More specifically, neither the Allen reference nor Ouchi '850 teach or contemplate a protector **"having a longitudinal axis"** with **"blade members having a generally rectangular planar shape, said blade members positioned in a co-planar orientation relative to said longitudinal axis."** Ouchi '377 does not cure the aforementioned deficiencies in what was fairly taught by Allen and Ouchi '850. That is, Ouchi '377 also does not appear to teach or contemplate a protector **"having a longitudinal axis"** with **"blade members having a generally rectangular planar shape, said blade members positioned in a co-planar orientation relative to said longitudinal axis."** Ouchi '377 teaches an injector instrument, or another treatment accessory for an endoscope that is used for injecting a medical fluid into tissue within a body cavity (column 1, lines 9-12). The cover tube (Fig. 55, ref. 21') does not have blade members that are generally of rectangular planar shape, and it is not positioned in a co-planar orientation relative to the longitudinal axis of the instrument.

Given these voids, one of ordinary skill in the art would not have been motivated to combine Allen, Ouchi '850, and Ouchi '377, nor would such a combination have led them to arrive at the present invention as claimed. Based on the foregoing, Applicants respectfully submit that Allen, Ouchi '850, and Ouchi '377, whether taken alone or in combination, fail to contain the requisite teaching or suggestion that would have lead one of ordinary skill in the art to the present invention.

Claims 71-74, being dependent upon and further limiting independent claim 58, should

be allowed for the reasons set forth above in support of the allowability of claim 58, as well as the additional features they contain. Applicants respectfully request that the rejection of claims 71-74 be withdrawn in favor of an indication of allowance, which is hereby earnestly solicited.

### **C. Allen in view of Ouchi '850 in view of Worthen**

Claim 66 was rejected under 35 USC § 103(a) as being unpatentable over Allen in view of Ouchi '850 in view of US Patent No. 5,445,164 to Worthen et al ("Worthen"). Applicant respectfully traverses this rejection in light of the amendments to the claims and as set forth below.

Claim 66 depends from independent claim 58. As noted above, both Allen and Ouchi '850 fail to teach or disclose each and every feature found in independent claim 58. More specifically, neither the Allen reference nor the Ouchi '850 reference teach or contemplate a protector **"having a longitudinal axis"** with **"blade members having a generally rectangular planar shape, said blade members positioned in a co-planar orientation relative to said longitudinal axis."** The Worthen reference does not cure the aforementioned deficiencies in what was fairly taught by Allen.

The Worthen reference does not teach or contemplate a protector **"having a longitudinal axis"** with **"blade members having a generally rectangular planar shape, said blade members positioned in a co-planar orientation relative to said longitudinal axis."** The Worthen reference discloses a "substantially cylindrical barrel" surrounding the circular sponge. (Col. 2 lines 29-30) The substantially cylindrical barrel is neither generally rectangular in shape, nor is it positioned in a co-planar orientation relative to the longitudinal axis of the instrument.

Given these voids, one of ordinary skill in the art would not have been motivated to combine the Allen, Ouchi '850, and Worthen references, nor would such a combination have led them to arrive at the present invention as claimed.

Claim 66, being dependent on independent claim 58, should be allowed for the reasons set forth above in support of allowability of claim 58, as well as the additional features it contains. Applicant respectfully requests that the rejection of claim 66 be withdrawn in favor of an indication of allowance, which is hereby earnestly solicited.

## CONCLUSION

The foregoing amendment has been submitted to place the present application in condition for allowance. It is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment. Reconsideration and allowance of the claims in this application is respectfully requested. In the event that there are any questions concerning this Amendment or the application in general, the Examiner is cordially invited to telephone the undersigned attorney or the attorney of record so that prosecution may be expedited.

Respectfully submitted,  
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